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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/117,795 11/10/98 SADO

M CU-1758RJS

EXAMINER

GARRETT, D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1774

DATE MAILED: 03/10/00

THOMAS F PETERSON
LADAS & FARRY
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IM62/0310

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/117,795

Applicant(s)

Sado

Examiner

Dawn Garrett

Group Art Unit

1774



☒ Responsive to communication(s) filed on 1-6-00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment, Paper No. 8, dated January 6, 2000. Claim 1 has been amended. Claims 1-3 are pending.
2. The text of those sections of Title 35, U.S. Code, not included in this action can be found in the prior Office action, paper no. 7, mailed November 2, 1999.
3. The rejection under 35 U.S.C. 112, second paragraph, of claims 1-3 as set forth in paper no. 7, paragraph 4 is withdrawn. Applicant has deleted the indefinite word “-type” from claim 1.
4. The rejection of claims 1-3 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 63069897 A (abstract) is maintained for the reasons set forth in paper no. 7, paragraph 8.
5. The rejection of claims 1-3 under 35 U.S.C. 103(a) as being unpatentable over Van Eenam (U.S. 5,158,710) is maintained for the reasons set forth in paper no. 7, paragraph 9.

Response to Arguments

6. Applicant's arguments filed January 6, 2000 have been fully considered but they are not persuasive.

Applicant argues JP 63069897 fails to teach or suggest a cleaning composition including both a benzyl alcohol (15-40% by weight) and a soluble organic solvent (5-75% by weight) as

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claimed in the present application. In response, the examiner maintains all elements of the instant claims are disclosed by JP 63069897 A. A combination of benzyl alcohol and diethylene glycol monobutyl ether in amounts of 0.2-50 % are disclosed in the preferred embodiment according to the reference abstract. Although any specific benefits of benzyl alcohol are not taught by JP 63069897 A, the component is clearly disclosed within the instantly claimed range. Applicant also argues JP 630769897A teaches a broader range than applicant. The examiner submits that the instantly claimed ranges are clearly within the taught ranges. No data or unexpected results of applicant's narrow ranges with respect to the reference broader ranges has been presented. Applicant argues the claimed ranges optimize releasability and reduced toxicity, but there is no data in support of the arguments. Per M.P.E.P. § 2145, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geiseler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). Moreover, arguments or conclusory statements unsupported by factual evidence are insufficient to establish unexpected results (see *In re Lindner*, 173 USPQ 356 (CCPA 1972)).

The applicant also argues Van Eenam fails to disclose or suggest the claimed composition of the present application. The examiner respectfully disagrees with the statement "This reference is also directed to a microemulsion which limits the soluble organic solvent to no more than 6% by weight to prevent the emulsion from becoming a true solution, col. 3, lines 7-9." Column 6, lines 7-9 do not teach a limit of 6% by weight limit of organic solvent and it is unclear where applicant has found this amount in the reference. Although no examples show a

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composition comprising 15 % by wt. benzyl alcohol, example 20, column 19 shows a composition comprising 9.0 wt. % benzyl alcohol. This example teaches an amount higher than that argued by applicant. Additionally, it would have been obvious to have optimized the component amounts, because “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation” (see *In re Aller*, 105 USPQ 233, 255 (CCPA 1955)). Accordingly, in the absence of sufficient, clear, and convincing evidence to the contrary, it is respectfully maintained that the examiner has established a proper case of *prima facie* obviousness against the instant claims.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Should you have any questions concerning this communication, please direct them to Dawn Garrett at 703-305-0788. The examiner can be reached at this number from about 8:00 am to about 5:00 pm E.S.T. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, William Krynski, can be reached at 703-308-2376. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1700 are 703-305-3599 for official after-final faxes, and 703-305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-2351.


D.G.

March 1, 2000


William Krynski
Supervisory Patent Examiner
Technology Center 1700